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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,418

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Chester O. Baxter III

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EXAMINER

TOY, ALEX B

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,418

Applicant(s)

BAXTER ET AL.

Examiner

Alex B. Toy

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 and 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in response to applicant's amendment filed on April 4, 2006. The objection to the incorrectly numbered claims is withdrawn in view of the appropriate amendment. All previous prior art rejections are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12 and 25-29 (claims 1-12 and second 24-28 as listed) are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vise* (U.S. Pat. No. 3,845,771) in view of *Laird* (U.S. Pat. No. 4,337,496).

Regarding claim 1, *Vise* discloses a medical device comprising:

a first electrode 14 attached to a first finger adapted for direct contact with a treatment site (col. 2, ln. 45-49 and Fig. 1); and

an electrically conductive wire 16 connected to the electrode 14 and a source of electrosurgical energy 20 (col. 3, ln. 1-17 and Figs. 1, 3, and 5).

The claim differs from Vise in calling for the medical device to comprise a first finger cuff assembly for mounting on the distal portion of an operator's finger. Laird, however, teaches a device comprising electrodes 61, 62 attached to a first finger cuff assembly 100 for mounting on the distal portion of an operator's finger to improve the stability of the electrodes on the finger (col. 7, ln. 39-43, col. 8, ln. 5-14, and Figs. 1 and 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a finger cuff assembly for mounting on the distal portion of an operator's finger in the invention of Vise in view of the teaching of Laird as an obvious alternate means for attaching the electrode that would improve the stability of the electrode on the finger.

Regarding claim 2, Vise discloses the medical device of claim 1 in view of Laird. In addition, Vise discloses that the frequency generator and the body of the patient are grounded "in accordance with accepted and conventional electrosurgical procedures" (col. 3, ln. 32-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the first electrode of Vise in view of Laird in conjunction with an electrosurgical grounding pad in view of Vise because electrosurgical grounding pads are a part of accepted and conventional electrosurgical

procedures that are well-known in the art. For example, see Klicek (U.S. Pat. No. 5,221,281) col. 5, ln. 18-23 and Fig. 1.

Regarding claim 3, Vise discloses the medical device of claims 1 and 2 in view of Laird. In addition, Vise discloses that the electric current is monopolar electrosurgical energy (col. 2, ln. 37-38 and Fig. 1).

Regarding claim 4, Vise discloses the medical device of claim 1 in view of Laird. In addition, Vise discloses the medical device, further comprising:

a second electrode 14a attached to a second finger (col. 3, ln. 61-64 and Fig. 4);
and

a second electrically conductive wire 17a connected to the second electrode 14a and a source of electrosurgical energy 20 (col. 4, ln. 9-14 and Figs. 4 and 5).

The claim differs from Vise in calling for the medical device to comprise a second finger cuff assembly for mounting on the distal portion of an operator's finger. Laird, however, teaches a device comprising electrodes 61, 62 attached to a finger cuff assembly 100 for mounting on the distal portion of an operator's finger to improve the stability of the electrodes on the finger (col. 7, ln. 39-43, col. 8, ln. 5-14, and Figs. 1 and 10-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a second finger cuff assembly for mounting on the distal portion of an operator's finger in the invention of Vise in view of the teaching of Laird as an obvious alternate means for attaching the second electrode that would improve the stability of the electrode on the finger.

Regarding claim 5, Vise discloses the medical device of claims 1 and 4 in view of Laird. In addition, Vise discloses the medical device, wherein the first electrode 14 is opposable to the second electrode 14a (Fig. 4). Therefore, the finger cuff assemblies of Vise in view of Laird, which the electrodes would be attached to, are opposable to each other.

Regarding claim 6, Vise discloses the medical device of claims 1, 4, and 5 in view of Laird. In addition, Vise discloses the medical device, wherein the first electrode 14 is opposable to the second electrode 14a (Fig. 4).

Regarding claim 7, Vise discloses the medical device of claims 1 and 4-6 in view of Laird. In addition, Vise discloses the medical device, wherein electric current is transmitted between the first electrode and second electrode (col. 4, ln. 9-14 and Figs. 4 and 5).

Regarding claim 8, Vise discloses the medical device of claims 1 and 4-7 in view of Laird. In addition, Vise discloses the medical device, wherein electric current is bipolar electrosurgical energy (col. 4, ln. 9-14 and Figs. 4 and 5).

Regarding claim 9, Vise discloses the medical device of claims 1 and 4 in view of Laird. The claim differs in calling for the first finger cuff and second finger cuff of Vise in view of Laird to further comprise a first grasping structure and a second grasping structure, respectively. The electrodes of Vise when placed on finger cuffs in view of Laird, however, comprise a first grasping structure and a second grasping structure capable of grasping tissue.

Regarding claim 10, Vise discloses the medical device of claims 1, 4, and 9 in view of Laird. The electrodes of Vise placed on finger cuffs in view of Laird comprise grasping structures that are capable of being removed from the first and second finger cuffs since Vise discloses that the electrodes are attached with an adhesive (col. 2, ln. 44-47).

Regarding claim 11, Vise discloses the medical device of claims 1, 4, and 9 in view of Laird. In addition, the first grasping structure of Vise is opposable to the second grasping structure (Fig. 4).

Regarding claim 12, Vise discloses the medical device of claims 1, 4, 9, and 11 in view of Laird. Since the electrodes of Vise comprise the grasping structures, electric current is transmitted between the first grasping structure and the second grasping structure.

Regarding claim 25, Vise discloses the medical device of claim 1 in view of Laird. In addition, Vise discloses the medical device, further comprising a glove 10, wherein the first electrode 14 is integral with the glove (col. 1, ln. 57-60 and Fig. 1). Therefore, the first finger cuff assembly of Vise in view of Laird, which the electrode would be attached to, is integral with the glove.

Regarding claim 26, Vise discloses the medical device of claims 1, 4, and 9 and a first grasping structure in view of Laird. In addition, Vise discloses that the electrode comprising the first grasping structure is made of "a strip of relatively fine, flexible, conductive metal wire mesh" (col. 2, ln. 47-48) that is capable of being bent or shaped by pressure to conform to a tissue profile that is encountered. Therefore, the first

grasping structure of Vise in view of Laird is malleable as defined by the applicant's specification.

Regarding claim 27, Vise discloses a medical device. The claim differs from Vise in calling for a first finger cuff assembly for mounting on a distal portion of an operator's finger and a second finger cuff assembly for mounting on a distal portion of an operator's finger. Laird, however, teaches a device comprising electrodes 61, 62 attached to a first finger cuff assembly 100 for mounting on the distal portion of an operator's finger to improve the stability of the electrodes on the finger (col. 7, ln. 39-43, col. 8, ln. 5-14, and Figs. 1 and 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a finger cuff assemblies for mounting on the distal portions of an operator's fingers in the invention of Vise in view of the teaching of Laird as an obvious alternate means for attaching the electrode that would improve the stability of the electrode on the finger.

The claim also differs from Vise in calling for a first grasping device attached to the first finger cuff assembly, and a second grasping device attached to the second finger cuff assembly. The electrodes of Vise when placed on finger cuffs in view of Laird, however, comprise a first grasping device and a second grasping device adapted for grasping tissue (Fig. 4).

Regarding claim 28, Vise discloses the medical device of claim 27 in view Laird. In addition, the first grasping device of Vise in view of Laird comprises at least one electrode adapted to transmit electric current directly to a treatment site.

Regarding claim 29, Vise discloses the medical device of claim 27 in view Laird. In addition, the first and second grasping devices of Vise in view of Laird each comprise at least one electrode adapted to transmit electric current.

Response to Arguments

Applicant's arguments filed April 4, 2006 have been fully considered but they are not persuasive. In response to applicant's argument that the device of Vise is not adapted for direct contact with a treatment site or adapted for grasping tissue, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In the instant case, regardless of the fact that Vise teaches only using the electrodes to grasp a surgical instrument, the electrode structures of Vise are still inherently capable of direct contact with a treatment site and inherently capable of grasping tissue. Therefore, the device of Vise in view of Laird meets the intended use of the amended claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*
6/12/06

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER